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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/672,132	09/26/2003	Whitney W. Noonan	20672-0002	6114
29052	7590	10/04/2004	EXAMINER	
SUTHERLAND ASBILL & BRENNAN LLP			ROANE, AARON F	
999 PEACHTREE STREET, N.E.			ART UNIT	PAPER NUMBER
ATLANTA, GA 30309			3739	

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/672,132	Applicant(s) NOONAN, WHITNEY W. 	
	Examiner Aaron Roane	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/4/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8-10, 12-16, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Dyrek (USPN 5,409,500).

Regarding claims 1 and 8, Dyrek discloses a thermal pack (112) for application to a female breast for therapeutic application of heat or cold to the breast comprising: a pliable, disk-shaped body (112) having an aperture (120) extending approximately through the center of the body, the body comprising a top wall (34 of figure 7) having an outer surface and an inner surface, an opposed bottom wall (36 of figure 7) having an outer surface and an inner surface, wherein the inner surface of the top wall and the inner surface of the bottom wall define at least one fluid tight cavity therebetween; and a thermal fluid (gel, col. 8, lines 10-24) contained in the at least one cavity, see col. 3-4, col. 8, lines 9-63 and figures 7 and 13-15.

Regarding claims 2 -5, Dyrek further discloses 4 baffles (116) are formed by a bond between the inner surface of the top wall and the inner surface of the bottom wall, wherein the baffles are in spaced relation to each other and each baffle extends from an outer edge of the body towards the aperture, see figures 13-15.

Regarding claim 6, Dyrek further discloses a fabric substantially covering the outer surface of the top wall, the outer surface of the bottom wall (122), or both, see col. 8, lines 25-61 and figures 7, 14 and 15.

Regarding claims 9, 10 and 12, Dyrek discloses the claimed invention, see col. 4-7 and figure 7.

Regarding claims 13-16, Dyrek discloses the claimed invention, see col. 4-7 and figures 7 and 13-15.

Regarding claims 18 and 19, Dyrek discloses a thermal pack (112) for application to a female breast for therapeutic application of heat or cold to the breast comprising: a pliable, disk-shaped body (112) having an aperture (120) extending approximately through the center of the body, the body comprising a top wall (34 of figure 7) having an outer surface and an inner surface, an opposed bottom wall (36 of figure 7) having an outer surface and an inner surface, wherein the inner surface of the top wall and the inner surface of the bottom wall define at least one fluid tight cavity therebetween; and a

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thermal fluid (gel, col. 8, lines 10-24) contained in the at least one cavity, see col. 3-4, col. 8, lines 9-63 and figures 7 and 13-15. Dyrek further discloses 4 baffles (116) are formed by a bond between the inner surface of the top wall and the inner surface of the bottom wall, wherein the baffles are in spaced relation to each other and each baffle extends from an outer edge of the body towards the aperture, see figures 13-15. Finally, Dyrek discloses a fabric substantially covering the outer surface of the top wall, the outer surface of the bottom wall (122), or both, see col. 8, lines 25-61 and figures 7, 14 and 15.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dyrek (USPN 5,409,500) in view of Evans (USPN 6,083,254).

Regarding claim 11, Dyrek discloses the claimed invention except for explicitly reciting that the fabric is a washable hypoallergenic fabric and covers only the outer surface of the top wall. Evans discloses a cold/hot pack and teaches providing the patient-contact

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surface 20 is preferably hypoallergenic in order to preferably increases user comfort by easing the shock of application to the body of a user, see col. 7 and figure 1-7. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Dyrek, as taught by Evans to provide the patient contacting surface with a hypoallergenic fabric in order to preferably increases user comfort by easing the shock of application to the body of a user.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dyrek (USPN 5,409,500).

Regarding claim 11, Dyrek discloses the claimed invention except for explicitly reciting that the polymer film comprises polyethylene or polypropylene. At the time of the invention, it would have been an obvious matter of design choice to one of ordinary skill in the art to use polyurethane layers because Applicant has not disclosed the layers of polyethylene or polypropylene provide an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the layers made of polyurethane as opposed to polyethylene or polypropylene because these materials provide the necessary thermal and mechanical (pliability) properties.

Claims 17 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dyrek (USPN 5,409,500) in view of Krafft (USPN 5,050,595).

Regarding claim 17, Dyrek discloses a thermal pack (112) for application to a female breast for therapeutic application of heat or cold to the breast comprising: a pliable, disk-shaped body (112) having an aperture (120) extending approximately through the center of the body, the body comprising a top wall (34 of figure 7) having an outer surface and an inner surface, an opposed bottom wall (36 of figure 7) having an outer surface and an inner surface, wherein the inner surface of the top wall and the inner surface of the bottom wall define at least one fluid tight cavity therebetween; and a thermal fluid (gel, col. 8, lines 10-24) contained in the at least one cavity, see col. 3-4, col. 8, lines 9-63 and figures 7 and 13-15. Dyrek discloses the claimed invention except for explicitly reciting a kit using two of the thermal packs. Dyrek is also silent to the application/securement of the thermal pack to the female breast with the nipple positioned within the aperture.

Krafft discloses a therapeutic garment for the female breast comprising brassiere (10) and teach the use of providing the brassiere with two thermal gel packs (32) and the explicitly securement of the thermal pack(s) to the female breast with the nipple positioned within the aperture in order to provide therapeutic thermal treatment to both breasts, see col. 1-6 and figures 1-7. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Dyrek, as taught by Krafft, to provide a brassiere with two thermal gel packs and the explicitly securement of the thermal pack(s) to the female breast with the nipple positioned within the aperture in order to provide therapeutic thermal treatment to both breasts.

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Regarding claims 21 and 22, Dyrek discloses the claimed invention, see col. 1-4-8 and figures 7, 13-15.

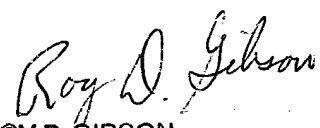
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (703) 305-7377. The examiner can normally be reached on 9am - 5pm, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.R. A. R.
October 1, 2004


ROY D. GIBSON
PRIMARY EXAMINER